Supreme Court, U.S.
FILED
OCT 28 2010
OFFICE OF THE CLERK

No. 10-426

In the Supreme Court of the United States

APPLERA CORP. AND TROPIX, INC.,
Petitioners,

v.

ENZO BIOCHEM, INC., ENZO LIFE SCIENCES, INC., AND YALE UNIVERSITY,
Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR YAHOO!, INC. AS *AMICUS CURIAE* SUPPORTING PETITIONERS

JASON C. WHITE
HOWREY LLP
321 North Clark Street
Chicago, IL 60610
(312) 595-2250

William C. Rooklidge
Counsel of Record
HOWREY LLP
4 Park Plaza, Suite 1700
Irvine, CA 92614
(949) 721-6900
RooklidgeW@howrey.com

Kevin T. Kramer
Yahoo!, Inc.
701 First Avenue
Sunnyvale, CA 94089
(408) 349-3300

Henry A. Petri, Jr.
HOWREY LLP
1111 Louisiana, 25th Floor
Houston, TX 77002
(713) 787-1400

Counsel for Amicus Curiae Yahoo!, Inc.

WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D.C. 20002

TABLE OF CONTENTS

STATEMENT OF INTEREST OF *AMICUS CURIAE* 1

SUMMARY OF THE ARGUMENT 3

ARGUMENT 4

I. This Court Should Grant The Petition To Review Whether The Federal Circuit's Test For Claim Definiteness Conflicts With The Patent Statute And This Court's Precedent 4

A. The Patent Statute Requires More Than Patent Claims That Are "Capable Of Construction" 5

B. This Court's Decisions Emphasize The "Public Notice" Aspect Of Patent Claims 6

C. Under This Court's Precedent, If A Claim Read In View Of The Specification Description Fails To Clearly Establish What The Patentee Regards As His Invention, The Claim Is Invalid 10

II. This Court Should Grant Applera's Petition To Resolve The Uncertainty Created By The Federal Circuit's Indefiniteness Test 12

III. The Proper Approach Balances The Claim Construction Exercise And The Definiteness Requirement Of The Patent Statute 17

CONCLUSION 18

TABLE OF AUTHORITIES

Page(s)

Cases

Bedrock Computer Technologies LLC v. Softlayer Technologies, Inc., et al., No. 6:09-CV-269-LED-JDL (E.D. Tex.) 2

Bell Atlantic Network Srvs., Inc. v. Covad Communications Group, Inc., 262 F.3d 1258 (Fed. Cir. 2001) 17

Bright Response, LLC v. Google Inc., et al., No. 2:07-CV-371-CE (E.D. Tex.) 2, 14, 15, 16

General Electric Co. v. Wabash Appliance Corp., 304 U.S. 364 (1938) 11, 16, 18, 19

Honeywell Int'l, Inc. v. United States, 609 F.3d 1292 (Fed. Cir. 2010) 4

Innovad Inc. v. Microsoft Corp., 260 F.3d 1326 (Fed. Cir. 2001) 17

Merrill v. Yeomans, 94 U.S. 568 (1877) 10, 11, 12

Paid Search Engine Tools, LLC v. Yahoo! Inc., No. 2:07-CV-403-DF-CE (E.D. Tex.) 2

Permutit Co. v. Graver Corp., 284 U.S. 52 (1931) 3, 6, 12, 13

Power-One, Inc. v. Artesyn Techs., Inc., 599 F.3d 1343 (Fed. Cir. 2010) 4

The Incandescent Lamp Patent,
159 U.S. 465 (1895) 12

Ultimax Cement Mfg. Corp. v. CTS Cement Mfg. Corp.,
587 F.3d 1339 (Fed. Cir. 2009) 4

United Carbon Co. v. Binney & Smith Co.,
317 U.S. 228 (1942) ..... passim

Universal Oil Prods. Co. v. Globe Oil & Refining Co.,
322 U.S. 471 (1944) 7, 16

White v. Dunbar,
119 U.S. 47 (1886) 18

Statutes

35 U.S.C. § 111(a)(2)A) 11

35 U.S.C. § 112, ¶2 ..... 2, 5, 11

35 U.S.C. § 251 11

Rules

37 C.F.R. § 1.111(b) 11

37 C.F.R. § 1.111(c) 11

37 C.F.R. § 1.51(b)(1) 11

STATEMENT OF INTEREST OF *AMICUS CURIAE*

Yahoo!, Inc. ("Yahoo!") respectfully submits this brief in support of the petition of Applera Corp. and Tropix, Inc. (collectively "Applera").[1] Yahoo! is a high-technology leader, owning and operating one of the most frequently visited websites on the Internet. Yahoo! attracts hundreds of millions of users every month through its innovative technology and engaging content and services, including Internet search capabilities, e-mail, and instant messaging. Yahoo! invests millions of dollars on its research and development efforts, which have led to hundreds of patents protecting the technology at the heart of Yahoo!'s business. Accordingly, Yahoo! recognizes first-hand the importance of patents and a healthy patent system.

At the same time, Yahoo!'s various products and services are increasingly the targets of infringement assertions by others. For example, at the beginning of 2007, Yahoo! was a defendant in four patent infringement suits. In contrast, Yahoo! is currently defending over 20 patent infringement suits. Most of the increase is due to suits brought by

---

[1] Yahoo! provided counsel of record with notice of its intent to file this brief more than ten days prior to the due date, as required by Supreme Court Rule 37.2(a), and both Petitioners and Respondents have consented to the filing of *amicus curiae* briefs. Such consents are on file with the Court. In accordance with Supreme Court Rule 37.6, Yahoo! states that this brief was not authored, in whole or in part, by counsel to a party, and that no monetary contribution to the preparation or submission of this brief was made by any person or entity other than Yahoo! or its counsel.

so-called non-practicing entities ("NPEs")—companies that do not practice their patented inventions, and many of which assert the patents in hopes of using the expense and uncertainties of litigation (particularly in jury cases) to obtain a windfall.

In several of its current cases, Yahoo! has argued that the asserted patent claims are invalid on the ground of indefiniteness. That is, Yahoo! has argued that the asserted claims fail to particularly point out and distinctly claim the subject matter that the patent applicant regards as his or her invention as required by 35 U.S.C. § 112, ¶2. *See Bright Response, LLC v. Google Inc., et al.*, No. 2:07-CV-371-CE (E.D. Tex.); *Paid Search Engine Tools, LLC v. Yahoo! Inc.*, No. 2:07-CV-403-DF-CE (E.D. Tex.); *Bedrock Computer Technologies LLC v. Softlayer Technologies, Inc., et al.*, No. 6:09-CV-269-LED-JDL (E.D. Tex.).

Based on Yahoo!'s balance of interests—as both owner of valuable patent rights and as the frequent target of infringement suits—Yahoo! respectfully provides its views on the critically important issue before this Court, *i.e.*, the proper standard for determining whether a patent claim is indefinite. Yahoo! hopes that the views expressed in this brief will assist the Court in deciding whether to address and resolve the important question presented by the petition.

SUMMARY OF THE ARGUMENT

This Court has long recognized that the statutory requirement that patents "particularly point[ ] out and distinctly claim[ ]" what the patentee regards as his invention exists for the benefit of the public. Without that "definiteness" requirement, there would be a "zone of uncertainty" around patent claims that competitors could enter only at the risk of an infringement suit. *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942). Patentees have the burden to draft clear patent claims to put the public on notice of "the limits of the monopoly asserted" so the public can know what features can be "safely used or manufactured without a license and which may not." *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 60 (1931).

The Federal Circuit has adopted an indefiniteness standard that abandons the public notice function of patent claims. Under the Federal Circuit's test, a claim is indefinite only if it "cannot be construed" or is "insolubly ambiguous." That standard disregards the statute and this Court's precedent. Competitors and members of the public desiring to know what they can practice without fear of infringement liability no longer can rely on the words of patent claims. Instead, they have to incur the costs of litigation to determine whether a trial court (or the Federal Circuit) will find some "soluble" meaning to the patent claims or give them some claim construction. The Federal Circuit's standard thus exacerbates the "zone of uncertainty" surrounding ambiguous patent claims.

The proper approach ought to give effect to the statutory language and this Court's precedent. A patent claim is definite only if it "particularly point[s] out and distinctly claim[s]" the invention so as to give the public notice of what is infringing. An ambiguous claim cannot be saved through claim construction or by adding limitations from the preferred embodiment during the claim construction exercise. Otherwise, the "zone of uncertainty" remains and claims lose their public notice function.

This Court now has the ideal opportunity to resolve the uncertainty concerning patent claims that the Federal Circuit's indefiniteness test has created. The Court should therefore grant the petition for writ of certiorari.

ARGUMENT

I. THIS COURT SHOULD GRANT THE PETITION TO REVIEW WHETHER THE FEDERAL CIRCUIT'S TEST FOR CLAIM DEFINITENESS CONFLICTS WITH THE PATENT STATUTE AND THIS COURT'S PRECEDENT

As illustrated by its decision here, the Federal Circuit holds that a patent claim is indefinite only if it "cannot be construed" (Pet. App. 10a) or is "insolubly ambiguous." *See, e.g., Honeywell Int'l, Inc. v. United States*, 609 F.3d 1292, 1301-02 (Fed. Cir. 2010); *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343, 1348 (Fed. Cir. 2010); *Ultimax Cement Mfg. Corp. v. CTS Cement Mfg. Corp.*, 587 F.3d 1339, 1352 (Fed. Cir. 2009). That standard, however, has no basis in the statute, and it is inconsistent with

this Court's precedent concerning the statutory definiteness requirement.

A. The Patent Statute Requires More Than Patent Claims That Are "Capable Of Construction"

The relevant section of the patent statute provides:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

35 U.S.C. § 112 ¶ 2. On its face, Section 112 ¶ 2 requires patent claims to "particularly point[ ] out and distinctly claim[ ]" what the patentee regards as his invention. The statute thus calls for more than claims that can somehow "be construed."

This Court's decision in *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228 (1942), illustrates that point. The two claims at issue recited "Su[b]stantially pure carbon black in the form of commercially uniform, comparatively small, rounded, smooth aggregates having a spongy or porous interior" and "As an article of manufacture, a pellet of approximately one-sixteenth of an inch in diameter and formed of a porous mass of substantially pure carbon black." *Id.* at 231-32. Based on the testimony of one of the inventors, the court was able to ascertain the meaning of each of the claim terms as used in the context of the patent:

"substantially pure," "commercially uniform," "comparatively small," "spongy," "porous," "pellet," and "approximately one-sixteenth of an inch in diameter." *Id.* at 233-34.

Despite those constructions, the Court held the claims indefinite because they failed both to distinguish the alleged invention from the prior art and to "clearly circumscribe what is foreclosed from future enterprise." *See id.* at 236-37. Under *United Carbon*, therefore, "definiteness" under the patent statute requires more than claims that are "amenable to construction."

B. This Court's Decisions Emphasize The "Public Notice" Aspect Of Patent Claims

This Court's precedent repeatedly emphasizes that patent claims have an important public notice function. As explained in *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 60 (1931),

> The statute requires the patentee not only to explain the principle of his apparatus and to describe it in such terms that any person skilled in the art to which it appertains may construct and use it after the expiration of the patent, but also to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.

See also, e.g., Universal Oil Prods. Co. v. Globe Oil & Refining Co., 322 U.S. 471, 484-85 (1944) ("The claim is the measure of the grant. The claim is required to be specific for the very purpose of protecting the public against extension of the scope of the patent.") (citation omitted); *United Carbon*, 317 U.S. at 233 ("To sustain claims so indefinite as to not to give the notice required by the statute would be in direct contravention of the public interest which Congress therein recognized and sought to protect.").

Thus, by requiring claims to "particularly point[ ] out and distinctly claim[ ]" the alleged invention, the definiteness requirement ensures there is no "zone of uncertainty" which "enterprise and experimentation may enter only at the risk of infringement claims." *United Carbon*, 317 U.S. at 326.

The indefiniteness test adopted by the Federal Circuit abandons that public notice function. Simply because a claim might be "amenable to construction" during litigation does not mean that the claim *per se* meets the statutory definiteness requirement. As explained above, this Court in *United Carbon* was able to determine the meaning of the patent claim terms, but nonetheless held the claims indefinite for failing to "clearly circumscribe what is foreclosed from future enterprise." *See United Carbon*, 317 U.S. at 236.

Applera's petition aptly illustrates the concern regarding the public notice function of patent claims. The '824 patent in suit included as one claim element "said linkage group not interfering substantially

with the characteristic ability of said compound to hybridize with said nucleic acid or of A to be detected." Pet. App. 5a (emphasis omitted). The Federal Circuit adopted the district court's construction of that element to mean "the linkage group neither substantially interferes with the ability of the compound to hybridize with the nucleic acid nor substantially interferes with the ability of A to be detected." *See* Pet. App. 7a, 12a-13a.

The court's claim construction merely reverses the word order of the phrase "interfering substantially," without giving any definition of how "substantial" any "interference" could be and still fall within the scope of the claims. Instead, the court cited examples from the specification from which one could supposedly determine how much was "substantial interference," including the description that "[i]t is even more preferred that the chemical linkage group be derived from a primary amine, and have the structure $-CH_2-NH-$ ...." Pet. App. 15a. Thus, according to the Federal Circuit, one skilled in the art could look to the specification examples to determine linkage groups that did not "substantially interfere."

The problem, however, is that some of the specification's examples are also in the prior art. *See* Pet. App. 20a ("[T]wo of Applera's prior art references ... employ a $-CH_2-NH-$ linkage group, which arguably belongs to the set of linkage groups disclosed in the patents-in-suit as 'even more preferred' embodiments."). Nevertheless, the Federal Circuit affirmed the denial of summary judgment of invalidity because, despite the

description of –CH_2–NH– linkage groups in the specification, Enzo's expert declared that the –CH_2–NH– linkage group of the prior art references would cause "substantial interference." *See* Pet. App. 21a-22a, 25a. The court noted that "there are an infinite variety of linkage groups 'derived from a primary amine, [with] the structure –CH_2–NH–' ... which suggests that not every 'even more preferred' linkage group would satisfy the not substantially interfering element." Pet. App. 24a.

According to the Federal Circuit's decision, the claims are definite because some examples cited in the specification *meet* the "substantially interfere" claim construction, while at the same time, the claims may not be anticipated because other examples cited as preferred embodiments in the specification *may not meet* the "substantially interfere" construction. Such a result fails to fulfill the public notice function of the claims. Because the patent provides no definition or meaningful explanation of "substantial interference," a competitor or other member of the public reading the Enzo patent specification could not know what linkage groups are within the scope of the claim. Under the Federal Circuit's decision, some example –CH_2–NH– linkage groups do not "substantially interfere" and are within the scope of the claims, while other example –CH_2–NH– linkage groups (per Enzo, the ones in the prior art) do "substantially interfere" and may be outside the claim scope—but the patent never explains the difference.

That result disregards the patent statute because, as this Court has stated, "[t]he statutory

requirement of particularity and distinctness in claims is met only when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise." *United Carbon*, 317 U.S. at 236. Examples in a patent specification that may or may not be prior art and may or may not be within the scope of the claim—without any explanation of how to determine that—cannot meet the definiteness requirement of the statute.

C. Under This Court's Precedent, If A Claim Read In View Of The Specification Description Fails To Clearly Establish What The Patentee Regards As His Invention, The Claim Is Invalid

Given this Court's precedent, the patent statute requires claims to be more than simply "amenable to construction." Under that precedent, if a claim, read in view of the remainder of the specification, fails to clearly establish what the patentee regards as his invention, the claim falls short of the requirements for a monopoly grant and is invalid. *See Merrill v. Yeomans*, 94 U.S. 568, 573 (1877) ("The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it, leave no excuse for ambiguous language or vague descriptions. The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights.")

Because the applicant is the author of the patent claims, the burden is on the patentee to

ensure that its claims "particularly point[ ] out and distinctly claim[ ]" the invention. *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 372 (1938) ("Congress requires, for the protection of the public, that the inventor set out a definite limitation of his patent; that condition must be satisfied before the monopoly is granted."); *Merrill*, 94 U.S. at 573-74 ("It seems to us that nothing can be more just and fair both to the patentee and the public, than that the former should understand and correctly describe just what he has invented, and for what he claims a patent."). The inventor presumably understands what his invention is. The patent applicant is the author of the patent claims. 35 U.S.C. § 111(a)(2)A); 35 U.S.C. § 112 ¶ 2; 37 C.F.R. § 1.51(b)(1). And, during examination of the patent application, the applicant has the ability to present new claims and amend existing claims. 37 C.F.R. § 1.111(b), (c). Thus, at all stages of the application process, the patentee has the ability to draft claims that will particularly point out and distinctly claim his invention. Even after the patent issues, if it becomes apparent that the claims are indefinite, the patentee still has the remedy of reissue in order to clarify the claims. 35 U.S.C. § 251; *see Merrill*, 94 U.S. at 573 ("If the patentee is also entitled to a patent for the product of this distillation, and has failed, as we think he has, to obtain it, the law affords him a remedy, by a surrender and re-issue. When this is done, the world will have fair notice of what he claims of, what his patent covers, and must govern themselves accordingly.").

Furthermore, as explained above, this Court's precedent recognizes that the "particularity" and

"distinctness" requirement of the patent statute is in part for the benefit of competitors and the public. Not only does the patent inform courts "of what they are called upon to construe," it serves the separate function of "appris[ing] ... competing manufacturers and dealers of exactly what they are bound to avoid." *The Incandescent Lamp Patent*, 159 U.S. 465, 474 (1895). *See also Permutit*, 284 U.S. at 60 ("The statute requires the patentee ... *to inform the public during the life of the patent of the limits of the monopoly asserted*, so that it may be known which features may be safely used or manufactured without a license and which may not.") (emphasis added); *Merrill*, 94 U.S. at 573 ("*The public* should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights.") (emphasis added). Therefore, whether the claims can be construed in a legal proceeding using the legal fiction of the hypothetical person of ordinary skill in the art is not determinative of whether the claims satisfy the public notice function of the "definiteness" requirement.

II. THIS COURT SHOULD GRANT APPLERA'S PETITION TO RESOLVE THE UNCERTAINTY CREATED BY THE FEDERAL CIRCUIT'S INDEFINITENESS TEST

This Court's precedent recognizes that the statutory requirement that patent claims particularly point out and distinctly claim an invention exists so that competitors may know what is covered, and what is not, so there is no "zone of uncertainty" concerning the patent claims. *United Carbon*, 317 U.S. at 236 ("A zone of uncertainty

which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field.").

By adopting a standard that holds claims indefinite only if they are "insolubly ambiguous" and not "amenable to construction," the Federal Circuit has in fact increased the "zone of uncertainty" surrounding patent claims. Under the Federal Circuit's test, competitors and other members of the public threatened with a patent having claims that are facially ambiguous cannot know whether they may be infringing until at least the conclusion of the claim construction proceedings. The public no longer can read the claims within the context of the patent to determine "which features may be safely used or manufactured without a license and which may not." *Permutit*, 284 U.S. at 60. Instead, competitors and other members of the public must face potential infringement suits and incur the costs of litigation at least through a formal claim construction to learn what the claims should have shown in the first place.

Yahoo! has experienced the "zone of uncertainty" the Federal Circuit's test has created in recent cases involving indefinite claims. As noted above, Yahoo! is facing an increasing number of infringement suits often brought by NPEs seeking to "monetize" patents they have purchased, either through a windfall jury verdict or a settlement. Several of those patents on their face seem to have no applicability to the products and services against which they are asserted, yet plaintiffs attempt to interpret the claims to cover Yahoo!'s business. In

those cases, Yahoo! has raised the defense of indefiniteness.

Because the Federal Circuit's test ties the statutory definiteness standard to the court's claim construction, parties seeking to stretch claims beyond the intended bounds of the patent are able to avoid the indefiniteness defense and increase Yahoo!'s costs to defend the suit. And if the court construes the claim, under the Federal Circuit's "not amenable to construction" standard, the claim will almost always be held definite, regardless of whether the claim as construed gives notice as to what infringes.

One recent example illustrates the point. In *Bright Response, LLC v. Google Inc.*, No. 2:07-CV-371-CE (E.D. Tex.), Bright Response, an NPE, sued Yahoo! for infringement of a patent with claims directed to a method of automatically interpreting and responding to electronic messages and that disclosed email messages as the preferred embodiment. Bright Response sought to read its patent claims on Yahoo!'s search advertising service. One independent method claim of Bright Response's patent included vague claim terms that were not defined in the specification and recited steps (a), (b), and (c). A dependent claim recited steps (b)(1)(i) and (ii) and (c) that, when added to the original method steps, formed a method that was not described in or supported by the specification. During claim construction, Yahoo! argued that the claim was indefinite based on the vague claim terms. In short, based on the claim language, it was impossible to determine whether step (b)(1) should be an

additional step or substituted for step (b) in the independent claim. The court ruled, however, that the claim was not "insolubly ambiguous" and rejected Yahoo!'s first indefiniteness argument. *See* Memorandum Opinion and Order at 8, No. 2:07-CV-371-CD, Dkt # 369 (E.D. Tex. June 18, 2010). The court also interpreted the method claim by ruling that "claim 28 requires the following steps: claim 26's step (a), claim 26's step (b), claim 28's step (b1), and claim 28's step (c)" rejecting Yahoo!'s second indefiniteness argument. *See* Memorandum Opinion and Order at 17, No. 2:07-CV-371-CD, Dkt # 369 (E.D. Tex. June 18, 2010). Because Yahoo!'s accused product performed its steps in a different order than required by the wording of the asserted claim, as construed by the court, Yahoo! prepared its noninfringement defense based on that claim construction.

In response to that noninfringement position, Bright Response's technical expert sought to testify that steps (b)(1) and (c) need not be performed in order. The district court granted Yahoo!'s request to exclude testimony inconsistent with the court's claim construction, namely that "step (b1) must occur before step (c)." Order, No. 2:07-CV-371-CD, Dkt # 594 (E.D. Tex. Aug. 3, 2010).

Yahoo! then continued its noninfringement defense based on that claim construction and its position that in its accused product step (b1) did not occur before step (c). On the third day of trial and at Bright Response's request, the court modified its claim construction, holding that step (c) was only "conditional" and "there is no order requirement

imposed on step (b1)(ii)." Order, No. 2:07-CV-371-CD, Dkt # 605 (E.D. Tex. Aug. 3, 2010).

Despite what Yahoo! thought was apparent from the face of the patent, the district court modified its claim construction mid-trial in response to Bright Response's arguments on claim construction made necessary by the specter of indefiniteness. That result is in direct contravention of the statutory requirement that the claims ought to have "particularly point[ed] out and distinctly claim[ed]" the invention "to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights." *General Electric*, 304 U.S. at 369. Bright Response obtained those "unreasonable advantages" first by alleging that claims directed to automatically responding to electronic messages covered Yahoo!'s advertising services, then by asking the court to re-construe the claims and expand their scope so as to rebut Yahoo!'s noninfringement positions based on the earlier claim constructions. *See Universal Oil Prods.*, 322 U.S. at 484-85 ("The claim is the measure of the grant. The claim is required to be specific for the very purpose of protecting the public against extension of the scope of the patent.") (citation omitted).

Under the Federal Circuit's "amenable to construction" test, however, the claims were not ruled indefinite, despite that Yahoo! had no notice of how it could be infringing until after three separate claim constructions by the district court.

III. THE PROPER APPROACH BALANCES THE CLAIM CONSTRUCTION EXERCISE AND THE DEFINITENESS REQUIREMENT OF THE PATENT STATUTE

United Carbon shows that claims may be indefinite even if the claims terms can be construed. Thus, the "zone of uncertainty" surrounding vague patent claims is avoided—not through claim construction or by a court determining whether the claims are "soluble"—but by the patentee drafting clear claims in the first place, putting the public and competitors on notice of what is foreclosed. The claim construction exercise should not be used to cure indefinite claims. Instead, the obligation to particularly point out and distinctly claim an invention is a separate requirement of the patent statute.

Also, it is well-established that, for purposes of claim construction, limitations from the description of the preferred embodiment cannot be read into claims. *Bell Atlantic Network Srvs., Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1270 (Fed. Cir. 2001) ("We are mindful of the fact that limitations from the specification may not be read into the claims."); *Innovad Inc. v. Microsoft Corp.*, 260 F.3d 1326, 1332 (Fed. Cir. 2001) (The "interpretative process forbids importing limitations from the specification into the defining language of the claims."). That same rule should apply for purposes of resolving an indefiniteness issue. If a claim is ambiguous on its face and could only be rendered definite by adding limitations from the preferred embodiment, then it is invalid. *General*

Electric, 304 U.S. at 374 (process limitations may not be read into the product claim to avoid indefiniteness: "to save the product claim in this fashion would constitute an improper importation into the claim of a factor nowhere described there.").

Permitting patent owners to treat a patent claim as a "nose of wax," re-wording its elements and adding limitations from the specification description in the guise of "construction," abandons the "public notice" function of claims. *Cf. White v. Dunbar*, 119 U.S. 47, 51 (1886) ("Some persons seem to suppose that a claim in a patent is like a nose of wax, which may be turned and twisted in any direction, merely by referring to the specification, so as to make it include something more than, or something different from, what its words express.") It is only by following the language of the statute and requiring patentees to "particularly point[ ] out and distinctly claim[ ]" the invention that the goal of public notice will be fulfilled and balance be restored to the patent system.

CONCLUSION

The patent statute and this Court's precedent require patentees to give notice to the public of what infringes by "particularly pointing out and distinctly claiming" the subject matter the patentee considers the invention. The Federal Circuit's rule that a claim is indefinite only if it is insolubly ambiguous and not amenable to construction eviscerates that requirement. Under the Federal Circuit's test, patent owners asserting patent against Yahoo! and others are effectively able to re-write their patent

claims until they obtain a claim scope to cover the accused products, without fear that the ever-changing claim scope could render the claim indefinite. As this Court has recognized, the patent statute places the burden on the patent applicant to write clear claims that particularly point out and distinctly claim the invention. Under the indefiniteness standard the Federal Circuit has adopted, however, the public has insufficient notice of what the claims cover, patentees can obtain "unreasonable advantages" (*General Electric*, 304 U.S. at 369), and there is a "zone of uncertainty" surrounding every patent that is not clear on its face. *United Carbon*, 317 U.S. 228.

The Court should grant Applera's petition and resolve the uncertainty that the Federal Circuit's indefiniteness standard has created.

Respectfully submitted.

JASON C. WHITE
HOWREY LLP
321 North Clark Street
Chicago, IL 60610
(312) 595-2250

Kevin T. Kramer
Yahoo!, Inc.
701 First Avenue
Sunnyvale, CA 94089
(408) 349-3300

William C. Rooklidge
Counsel of Record
HOWREY LLP
4 Park Plaza, Suite 1700
Irvine, CA 92614
(949) 721-6900

Henry A. Petri, Jr.
HOWREY LLP
1111 Louisiana, 25th Floor
Houston, TX 77002
(713) 787-1400

OCTOBER 28, 2010